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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 09/882,081      | 06/15/2001  | Karel-Jan Van Der Toorn | NL 000327           | 9487             |

7590 07/30/2002

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EXAMINER

WILSON, LEE D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3723     |              |

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                          |
|------------------------------|-----------------|--------------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)             |
|                              | 09/882,081      | VAN DER TOORN, KAREL-JAN |
|                              | Examiner        | Art Unit                 |
|                              | LEE D WILSON    | 3723                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 January 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in EPO 00202080.8 on 6/15/00. It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the detection means must be shown or the feature(s) canceled from claim 10. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a **single paragraph** on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed

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150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because the abstract is in two paragraphs. The abstract should be in narrative form and generally limited to **a single paragraph**. Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following subheadings do not all appear in the specification. Applicant should insert missing sub headings see the Content of Specification below. Appropriate correction is required.

### **Content of Specification**

(a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

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- b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.  
\*  
(c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
  
- (d) Reference to a "Microfiche Appendix": See 37CFR 1.96(c) and MPEP § 608.05, if the application was filed before March 1, 2001. The total number of microfiche and the total number of frames should be specified. Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc and an incorporation by reference of the material on the compact disc.
  
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  
  - (2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and

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\*problems involved in the prior art which are solved by the applicant's invention.

This item may also be titled "Background Art."

- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and \*+accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and

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their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims.
- (k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.
- \*(l) Sequence Listing, if on paper: See 37 CFR 1.821-1.825.

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***Claim Objections***

6. Claims 2-8 are objected to because of the following “characterized” is used in the dependent claims which depend from a claim using “comprising”. Furthermore, the term “characterized” is terminolgy that is not standard U.S. practice. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**a. The following claims lack proper antecedent basis:**

- i. “the side” in claim 1, line 4. This has not been previously mentioned.
- ii.“the side” in claim 1, line 5. The guide member has not been previously mentioned as having a side.
- iii. Claims 2-9 should recite “The” instead of “A” to have proper antecedent basis in the preambles.
- iv. “the location of two mutually perpendicular outer sides” in claim 5, line 2. The guide member has not been previously mentioned as having a location of two mutually perpendicular outer sides.

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- b.The following phrases are vague, indefinite, and/or awkwardly and confusingly worded:**
- i. Claim 10 should positively recite all of the limitations of claim 1. To refer to claim 1 without reciting any limitations makes claim 10 indefinite.
  - ii. "preferably" in claim 7, line 4. Are limitations being claimed or not?????
  - iii. Regarding claim 8, line 3, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2, 7, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Snell (6152435).

Snell disclose a holder having a base plate (20), a guide member (24) with two guides (60&62) with two tapering sides and three guides (fig.3B).

10. Claims 1-2, 4, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Engibarov (5060920).

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Engibarov disclose a holder having a base plate (10), a guide member (18) with three guides with two tapering sides (see fig.7 which element 29 has two tapering sides or fig.9 with elements 66&68, all of these read) and the guide is secured (col.3, lines 24-27) to a slot (20) by nut (19) and bolt (25)

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engibarov (5060920) in view of McConkey (5074536).

- a. Engibarov is discussed above.
- b. Engibarov does not disclose guide members with a trapezodial shape.
- c. McConkey discloses a holder having guide members with a trapezodial shape (15&18) which is an alternative shape used to hold a workpiece.

d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Engibarov device by providing a trapezoidal shape as taught by McConkey which used as an alternative shape used to hold a workpiece.

13. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engibarov (5060920) in view of Gaither (3626600).

- a. Engibarov is discussed above.

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- b. Engibarov does not disclose guide members with a trapezodial shape.
- c. Gaither discloses a holder having a guide member (19) and a base (18) that is graduated which allows the movements of the guide member to be measured.
- d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Engibarov device by providing a base that is graduated as taught by Gaither which allows the movements of the guide member to be measured.

14. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engibarov (5060920).

- a. Engibarov is discussed above.
- b. In regard to claim 6, Engibarov discloses the claimed invention except for aluminum. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made nuts and bolt out of aluminum, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.
- c. In regard to claim 8, Engibarov discloses the claimed invention except for a material having a low coefficient of friction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made a guide member out of a material with a low coefficient of friction, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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15. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engibarov (5060920) in view of Takisawa et al (6383890).

- a. Engibarov is discussed above.
- b. Engibarov does not disclose a detection means.
- c. Takisawa et al disclose a holder having a detection means which allows the position of the workpiece to be determined.
- d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Engibarov device by providing a position sensor as taught by Takisawa et al which allows the position of the workpiece to be determined.

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kroenke, Greene, Davis, and Yang disclose a device.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Wilson whose telephone number is (703) 305-4094.

ldw

July 15, 2002



Lee Wilson  
Patent Examiner